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Date: September 20, 2010

By /Jennifer Archer/  
Jennifer Archer

Docket No. 101769-254 KGB  
Confirmation No. 8156

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

APPLICANT : Ralf SCHLIEPHACKE et al  
SERIAL NO. : 10/830,172  
CUSTOMER NO. : 27384  
FILED : April 21, 2004  
FOR : METHOD FOR DIECUTTING A WEB WHICH IS PROVIDED  
WITH ADHESIVE AT LEAST ON ONE SIDE AND IS ON A  
BACKING MATERIAL INTO INDIVIDUAL DIECUTS  
ART UNIT : 1791  
EXAMINER : James Sells

Mail Stop-Appeal Brief-Patent  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

**APPELLANTS' REPLY BRIEF PURSUANT TO 37 CFR § 41.41**

SIR:

A couple of points in the Examiner's Answer merit brief reply:

First, in the middle of page 7 of the Examiner's Answer, the Examiner continues along the line that "[f]eeding/dispensing diecut materials at a rate in the range recited in Appellant's claims is known in the prior art (see Scholz et al — paragraph [0056] as described above)." This is in spite of the fact that on pages 12-13 of the appeal brief Appellants explained that Scholz's

references were to diecutting and matrix-stripping, **not** dispensing of previously diecut, matrix-stripped diecuts from a dispensing device.

Appellants have explained that diecutting and matrix-stripping are not the same as dispensing. See the middle of page 12 of the Appeal Brief. However, the Examiner does not respond to Appellants' explanation at all, and only repeats robotically what he has been writing all along, i.e., that Scholz teaches the improvement now urged. Appellants respectfully submit that this is not a proper response to Appellants' arguments. Rather, this shows that the Examiner has rigidly ignored Appellants' argument.

Indeed, in the first paragraph on page 8, he continues with this error, finding motivation “to provide the predictable result of **producing** articles at a fast rate of speed (emphasis added).” Appellants' unexpected result does **not** pertain to producing the diecuts (which is what Scholz is talking about), but, rather, to **using or applying** the diecuts after they have been produced. Appellants' unexpected result—urged all along, and completely misunderstood—is that the non-straight line cut is a result-effective variable concerning the speed with which already produced diecut can be **dispensed** from a dispenser. This unexpected result is nowhere taught or suggested by the cited prior art. The prior art does not teach or suggest this finding, and, thus, cannot render an invention based on this finding *prima facie* obvious. See, e.g., *In re Antoine*, 195 USPQ 6 (CCPA 1977), for the proposition that there is no motivation to optimize a variable where the prior art does not reveal the optimized variable to be result-effective.

Second, the Examiner adds **for the very first time** an objection that the data are not commensurate in scope with the claims. See, again, the second paragraph on page 7 of the Examiner's Answer. Since this is a new point, and this is the Reply Brief, Appellants are put at a

significant disadvantage. However, Appellants would refer the Honorable Board to the specification at page 25, lines 19-30, explaining the underlying theory for the improvement demonstrated. A person having ordinary skill in the art, reading the instant specification would understand that the increase in speed is due to the increased cohesive forces between diecuts produced by non-straight line diecutting compared to straight-line diecutting. Such a person would further understand that the exemplification of the improvement using an undular line would have been expected to be **representative** of the similar results that could reasonably be expected using other non-straight line diecuts. *See, MPEP* § 716.02(d)(I) (“Nonobviousness of a Genus or Claimed Range May be Supported by Data Showing Unexpected Result of a Species or Narrower Range under Certain Circumstances”), citing *In re Kollman*, 595 F.2d 48, 201 USPQ 193 (CCPA 1979).

For the reasons advanced in Appellants' Brief on Appeal and for the further reasons advanced above, Appellants respectfully request that the Honorable Board reverse the final rejection.

### ADDITIONAL FEE

Please charge any insufficiency of fees, or credit any excess to our Deposit Account No. 14-1263.

Respectfully submitted,

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By           /Kurt G. Briscoe/

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